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| 10/784,481 | 02/19/2004 | Jonathan Wong | 018158-025100US | 1814 |
| 20350 7590 11/19/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834 | | | EXAMINER STULTZ, JESSICA T | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,481

Applicant(s)

WONG ET AL.

Examiner

Jessica T. Stultz

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-16 and 33-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-16 and 33-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 0805
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group IA, claim 1-16 and 33-45 in the reply filed on September 6, 2007 is acknowledged. However, claims 8-10 and 45 have been cancelled; therefore these claims have not been considered in the following action.

Claims 17-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 6, 2007.

Information Disclosure Statement

The information disclosure statement filed August 23, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Specifically, pages 3-4 have not been considered. Applicant states that the copies of these references can be found in Applications 10/300,714 and 10/460,060, however, these applications are not relied upon for an earlier filing date under 35 U.S.C. 120 as required by 37 CFR 1.98(d) and therefore these documents have not been considered. See MPEP 609.

Claim Objections

Claims 11-13 are objected to because of the following informalities: Claim 11 depends from cancelled claim 8. Claims 11-12 recite the limitation "obtaining the image" in claim 8. There is insufficient antecedent basis for this limitation in the claim since claim 8 has been

cancelled. Claim 13 recites the limitation "illuminating the eye" in claim 8. There is insufficient antecedent basis for this limitation in the claim since claim 8 has been cancelled. Appropriate correction is required. For purposes of examination, the assumed meaning of claim 11 is "a method as in claim 1, further comprising: obtaining an image of the eye, wherein obtaining the image"; and the assumed meaning of claim 13 is "a method as in claim 3".

Specification

The disclosure is objected to because of the following informalities: the "Brief Description of the Drawings" section should include Figure "3A". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al US 5,280,312, herein referred to as Yamada et al '312.

Regarding claim 1, Yamada et al '312 disclose a method of determining whether an image of an eye is of a left eye or a right eye (Column 4, lines 13-60, Column 5, lines 62-68 and Column 7, line 61-Column 8, line 5, wherein the system "109" comprises an eyeball discrimination circuit, Figures 1A0-B and 2), the method comprising: locating an iris center on the image (Column 1, line 46-Column 2, line 2, Column 4, lines 34-49, and Column 6, line 21-Column 7, line 17, wherein the light emitting diodes "5c" and "5d" illuminate the iris and locate

the center "c" thereof, Figures 4A-B and 6A-B); locating a corneal vertex on the image (Column 4, lines 24-33, and Column 6, line 21-Column 7, line 60, wherein the light emitting diodes "5a" and "5b" illuminate the cornea and locate the point where the optical axis crosses the surface, i.e. corneal vertex, Figures 4A-B and 5A-B); and determining whether the image is of a left eye or a right eye, based on the location of the corneal vertex relative to the iris center (Column 6, line 21-Column 8, line 5, wherein the eye discrimination device uses the iris center and corneal vertex measurements to determine if the observed eye is the right or left eye, Figure 7).

Regarding claim 2, Yamada et al '312 further discloses locating a center of a pupil of the eye on the image before locating the center of the iris (Column 1, line 46-Column 2, line 2, Column 4, lines 34-49, and Column 6, line 21-Column 7, line 17, wherein the pupil center is first measured to determine the iris center).

Regarding claim 3, Yamada et al '312 further discloses that locating the corneal vertex comprises locating at least one reflection on the image, wherein the at least one reflection is caused by illuminating the eye while acquiring the image (Column 4, lines 24-33, and Column 6, line 21-Column 7, line 60, wherein the light emitting diodes "5a" and "5b" illuminate the cornea and locate the point where the optical axis crosses the surface, i.e. corneal vertex, based on reflection images detected by photoelectric element array "6", Figures 4A-B and 5A-B).

Regarding claim 4, Yamada et al '312 further discloses that determining whether the image is of a left eye or a right eye comprises assuming that the at least one reflection is displaced, relative to the iris center, toward a nose of a patient from whom the image was acquired (Column 6, line 21-Column 7, line 60, wherein displaced reflection data, as shown in Figures 4A-B and 5A-B, is used to determine the visual axis location, Figure 7).

Regarding claim 5, Yamada et al '312 further discloses that determining further comprises: measuring a displacement of the at least one reflection toward the nose, relative to the iris center; and determining whether the image is of the left eye or the right eye, based on the measured displacement (Column 6, line 21-Column 7, line 60, wherein displaced reflection data, as shown in Figures 4A-B and 5A-B, is used to determine the visual axis location, wherein the visual axis data is used to discriminate between the left eye and right eye, Figure 7).

Regarding claim 6, Yamada et al '312 further discloses that the determining further comprises: measuring a displacement of the at least one reflection toward the nose, relative to the iris center; comparing the measured displacement with a predetermined threshold displacement; and determining whether the image is of the left eye or the right eye only if the measured displacement is equal to or greater than the predetermined threshold (Column 6, line 21-Column 7, line 60, wherein displaced reflection data as claimed, as shown in Figures 4A-B and 5A-B, is used to determine the visual axis location, wherein the data corresponds to known data regarding each eye specifically and is used to discriminate between the left eye and right eye, Figure 7).

Regarding claim 13, Yamada et al '312 further discloses that illuminating the eye comprises illuminating the pupil using at least one infrared light source disposed near an opening through which the eye image is acquired (Column 6, line 1-62, wherein the eye is illuminated with infrared light emitting diodes "5a-d", Figures 4A-B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al '312, as applied to independent claim 1 above, in view of Hirohara et al US 6,685,320, herein referred to as Hirohara et al '320.

Regarding claim 7, Yamada et al '312 discloses a method of determining whether an image of an eye is of a left eye or a right eye, and but does not specifically disclose that the step of determining a predetermined threshold comprises determining the predetermined threshold in response to a sub-population group of a patient having the eye. In the same field of endeavor of eye observation methods (Column 10, lines 11-42), Hirohara et al '320 teaches of comparing eye images to predetermined right and left eye images of the patient (Column 10, lines 11-42) for the purpose of determining the refractive power and astigmatism of the imaged eye (Column 10, lines 11-42). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of determining whether an image of an eye is of a left eye or a right eye of Yamada et al '312 to further comprise the step of determining a predetermined threshold comprises determining the predetermined threshold in response to a sub-population group of a patient having the eye since Hirohara et al '320 teaches of comparing eye images to predetermined right and left eye images of the patient for the purpose of determining the refractive power and astigmatism of the imaged eye.

Regarding claims 11-12, Yamada et al '312 discloses a method of determining whether an image of an eye is of a left eye or a right eye, and further discloses a step of obtaining the image of the eye, specifically obtaining an image of a pupil of the eye (Column 1, line 46-Column 2,

line 2, Column 4, lines 34-49, and Column 6, line 21-Column 7, line 17, wherein the an image of the pupil is obtained), but does not specifically disclose the step of obtaining the image comprises imaging the eye using a wavefront imaging device. In the same field of endeavor of eye observation methods (Column 10, lines 11-42), Hirohara et al '320 teaches of obtaining an image of the eye using a wavefront imaging device (Column 7, lines 38-50 and Column 10, lines 11-42) for the purpose of obtaining multiple images to compare with previously captured left and right eye images to determine the refractive power and astigmatism of the imaged eye (Column 10, lines 11-42). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of determining whether an image of an eye is of a left eye or a right eye of Yamada et al '312 to further comprise the step of obtaining the image comprises imaging the eye using a wavefront imaging device since Hirohara et al '320 teaches of obtaining an image of the eye using a wavefront imaging device for the purpose of obtaining multiple images to compare with previously captured left and right eye images to determine the refractive power and astigmatism of the imaged eye.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al '312, as applied to independent claim 1 above, in view of Kato US 5,822,446, herein referred to as Kato '446.

Regarding claims 14-16, Yamada et al '312 discloses a method of determining whether an image of an eye is of a left eye or a right eye, and further discloses that a warning signal is provided based on the determination of whether the image is of a left eye or a right eye (Column 5, line 62-68 and Column 7, line 61-Column 8, line 19), but does not specifically disclose verifying that a correct eye has been selected on which to perform a laser eye surgery procedure,

based on the determination of whether the image is of a left eye or a right eye, providing a warning to a user of a laser eye surgery system before the system is used to perform a laser eye surgery procedure on an incorrect eye, and performing a customized laser eye surgery procedure on the eye, based on the determination of whether the image is of a left eye or a right eye. In the same field of endeavor of methods of determining whether an image of an eye is of a left eye or a right eye (Column 5, line 39-Column 6, line 61, wherein the method is performed by eye discriminating means "35", Figures 1-2), Kato '446 teaches of the eye discrimination information being used to provide customized laser eye surgery to a selected eye (Column 8, lines 41-53 and Column 10, lines 4-17, wherein the selected eye undergoes laser coagulation, i.e. laser eye surgery) for the purpose of diagnosis and treating a diseased portion of a desired eye (Column 10, lines 4-51). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of determining whether an image of an eye is of a left eye or a right eye of Yamada et al '312 to further comprise the steps of verifying that a correct eye has been selected on which to perform a laser eye surgery procedure, based on the determination of whether the image is of a left eye or a right eye, providing a warning to a user of a laser eye surgery system before the system is used to perform a laser eye surgery procedure on an incorrect eye and performing a customized laser eye surgery procedure on the eye, based on the determination of whether the image is of a left eye or a right eye since Kato '446 teaches of the eye discrimination information being used to provide customized laser eye surgery to a selected eye for the purpose of diagnosis and treating a diseased portion of a desired eye.

Claims 33-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al '312, as applied to independent claim 1 above, in view of Kato '446, and further in view of Hirohara et al '320.

Regarding claim 33, Yamada et al '312 discloses a method comprising: obtaining an image of an eye (Column 1, line 46-Column 2, line 2, Column 4, lines 34-49, and Column 6, line 21-Column 7, line 17, wherein an image of the eye is obtained), determining whether the image is of a left eye or a right eye (Column 4, lines 13-60, Column 5, lines 62-68 and Column 7, line 61-Column 8, line 5, wherein the system "109" comprises an eyeball discrimination circuit, Figures 1A0-B and 2), based on nasally-directed displacement (Column 6, line 21-Column 7, line 60, wherein displaced reflection data, as shown in Figures 4A-B and 5A-B, is used to determine the visual axis location, Figure 7) of a corneal vertex on the image relative to an iris center on the image (Column 6, line 21-Column 8, line 5, wherein the eye discrimination device uses the iris center and corneal vertex measurements to determine if the observed eye is the right or left eye, based on the visual axis locations, Figure 7), but does not specifically disclose that the method comprises performing laser eye surgery, comprising the step of verifying that a correct eye has been selected on which to perform a laser eye surgery procedure, based on the determination of whether the image is of a left eye or a right eye. In the same field of endeavor of methods of determining whether an image of an eye is of a left eye or a right eye (Column 5, line 39-Column 6, line 61, wherein the method is performed by eye discriminating means "35", Figures 1-2), Kato '446 teaches of the eye discrimination information being used to provide customized laser eye surgery to a selected eye (Column 8, lines 41-53 and Column 10, lines 4-17, wherein the selected eye undergoes laser coagulation, i.e. laser eye surgery) for the purpose

of diagnosis and treating a diseased portion of a desired eye (Column 10, lines 4-51). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of Yamada et al '312 to further comprise the steps of verifying that a correct eye has been selected on which to perform a laser eye surgery procedure, based on the determination of whether the image is of a left eye or a right eye, since Kato '446 teaches of the eye discrimination information being used to provide customized laser eye surgery to a selected eye for the purpose of diagnosis and treating a diseased portion of a desired eye.

Yamada et al '312 and Kato '446 disclose and teach of a method of performing laser surgery as shown above, but do not specifically disclose that the step of obtaining an image of an eye comprise the steps of acquiring a wavefront measurement of an eye; obtaining an image of the eye during the wavefront measurement; and generating a treatment for the eye based on the wavefront measurement. In the same field of endeavor of eye observation methods (Column 10, lines 11-42), Hirohara et al '320 teaches of obtaining an image of the eye using a wavefront imaging device (Column 7, lines 38-50 and Column 10, lines 11-42) and generating a treatment for the eye based on the wavefront measurement (Column 19, lines 4-39) for the purpose of obtaining multiple images to compare with previously captured left and right eye images to determine the refractive power and astigmatism of the imaged eye (Column 10, lines 11-42). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of performing laser surgery of Yamada et al '312 and Kato '446 to further comprise the steps of acquiring a wavefront measurement of an eye; obtaining an image of the eye during the wavefront measurement; and generating a treatment for the eye based on the wavefront measurement since Hirohara et al '320 teaches of obtaining an image of

the eye using a wavefront imaging device and generating a treatment for the eye based on the wavefront measurement for the purpose of obtaining multiple images to compare with previously captured left and right eye images to determine the refractive power and astigmatism of the imaged eye.

Regarding claim 34, Yamada et al '312, Kato '446, and Hirohara et al '320 disclose and teach of a method of performing laser surgery as shown above, and Yamada et al '312 further discloses that determining whether an image of an eye is of a left eye or a right eye (Column 4, lines 13-60, Column 5, lines 62-68 and Column 7, line 61-Column 8, line 5, wherein the system "109" comprises an eyeball discrimination circuit, Figures 1A0-B and 2), comprises: locating the iris center on the image (Column 1, line 46-Column 2, line 2, Column 4, lines 34-49, and Column 6, line 21-Column 7, line 17, wherein the light emitting diodes "5c" and "5d" illuminate the iris and locate the center "c" thereof, Figures 4A-B and 6A-B); locating the corneal vertex on the image (Column 4, lines 24-33, and Column 6, line 21-Column 7, line 60, wherein the light emitting diodes "5a" and "5b" illuminate the cornea and locate the point where the optical axis crosses the surface, i.e. corneal vertex, Figures 4A-B and 5A-B); and comparing the location of the corneal vertex to the location of the iris center (Column 6, line 21-Column 8, line 5, wherein the eye discrimination device uses the iris center and corneal vertex measurements to determine if the observed eye is the right or left eye, Figure 7).

Regarding claim 35, Yamada et al '312, Kato '446, and Hirohara et al '320 disclose and teach of a method of performing laser surgery as shown above, and Yamada et al '312 further discloses that locating the corneal vertex comprises locating at least one reflection on the image, wherein the at least one reflection is caused by illuminating the eye while acquiring the image

(Column 4, lines 24-33, and Column 6, line 21-Column 7, line 60, wherein the light emitting diodes "5a" and "5b" illuminate the cornea and locate the point where the optical axis crosses the surface, i.e. corneal vertex, based on reflection images detected by photoelectric element array "6", Figures 4A-B and 5A-B).

Regarding claim 36, Yamada et al '312, Kato '446, and Hirohara et al '320 disclose and teach of a method of performing laser surgery as shown above, and Yamada et al '312 further discloses that determining whether the image is of a left eye or a right eye comprises assuming that the at least one reflection is displaced, relative to the iris center, toward a nose of a patient from whom the image was acquired (Column 6, line 21-Column 7, line 60, wherein displaced reflection data, as shown in Figures 4A-B and 5A-B, is used to determine the visual axis location, Figure 7).

Regarding claim 37, Yamada et al '312, Kato '446, and Hirohara et al '320 disclose and teach of a method of performing laser surgery as shown above, and Yamada et al '312 further discloses that determining further comprises: measuring a displacement of the at least one reflection toward the nose, relative to the iris center; and determining whether the image is of the left eye or the right eye, based on the measured displacement (Column 6, line 21-Column 7, line 60, wherein displaced reflection data, as shown in Figures 4A-B and 5A-B, is used to determine the visual axis location, wherein the visual axis data is used to discriminate between the left eye and right eye, Figure 7).

Regarding claim 38, Yamada et al '312, Kato '446, and Hirohara et al '320 disclose and teach of a method of performing laser surgery as shown above, and Yamada et al '312 further discloses that the determining further comprises: measuring a displacement of the at least one

reflection toward the nose, relative to the iris center; comparing the measured displacement with a predetermined threshold displacement; and determining whether the image is of the left eye or the right eye only if the measured displacement is equal to or greater than the predetermined threshold (Column 6, line 21-Column 7, line 60, wherein displaced reflection data as claimed, as shown in Figures 4A-B and 5A-B, is used to determine the visual axis location, wherein the data corresponds to known data regarding each eye specifically and is used to discriminate between the left eye and right eye, Figure 7).

Regarding claim 39, Yamada et al '312, Kato '446, and Hirohara et al '320 disclose and teach of a method of performing laser surgery as shown above, and Yamada et al '312 further discloses locating a center of a pupil of the eye on the image before locating the iris center (Column 1, line 46-Column 2, line 2, Column 4, lines 34-49, and Column 6, line 21-Column 7, line 17, wherein the pupil center is first measured to determine the iris center).

Regarding claims 40-42, Yamada et al '312, Kato '446, and Hirohara et al '320 disclose and teach of a method of performing laser surgery as shown above, and Yamada et al '312 further discloses illuminating the eye before obtaining the image of the eye with at least one infrared light source, specifically with at least two infrared light emitting diodes disposed near an opening through which the image is acquired (Column 6, line 1-62, wherein the eye is illuminated with infrared light emitting diodes "5a-d", Figures 4A-B).

Regarding claims 43-44, Yamada et al '312, Kato '446, and Hirohara et al '320 disclose and teach of a method of performing laser surgery as shown above, and Yamada et al '312 further discloses obtaining an image of a pupil of the eye (Column 1, line 46-Column 2, line 2, Column 4, lines 34-49, and Column 6, line 21-Column 7, line 17, wherein the an image of the pupil is

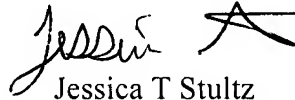
obtained) and Hirohara et al '320 further teaches of obtaining an image of the eye using a wavefront imaging device (Column 7, lines 38-50 and Column 10, lines 11-42).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T. Stultz whose telephone number is (571) 272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jessica T Stultz
Examiner
Art Unit 2873
November 10, 2007